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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10-059,400	01.31.2002	S. Christopher Early		6086

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EXAMINER

GRUNBERG, ANNE MARIE

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 03/25/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/059,400

Applicant(s)

S. Christopher Early

Examiner

Anne Marie Grunberg

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 31, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jan 31, 2002 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

### ***Format***

**Additionally, the pages need to be numbered consecutively in accordance with 37 CFR 1.52(5). The pages of the specification, including the claims and the abstract, must be numbered consecutively, starting with 1, the numbers being centrally located and preferably located below the text.** The claim and abstract each must appear on separate pages.

### ***Amendment***

For information concerning the proper format for any future amendments to the specification, the procedures may be viewed on the Internet at <http://www.uspto.gov>. under

"Patents". Additionally, Applicant is encouraged to provide a substitute specification under 37 CFR 1.125 because it is anticipated that the number and nature of the amendment and the resulting legibility of the application papers will render it difficult to consider the revised application, and will render it difficult to arrange the papers for printing or copying.

### ***Drawings***

Applicant has submitted three color drawings (photos). Applicant is advised that the rules for submitting drawings, 37 CFR 1.84 and 37 CFR 1.165, were amended effective November 29, 2000. The USPTO delayed enforcement of these changes until October 1, 2001. The application was submitted after October 1, 2001, and the drawings as submitted, are not in accordance with the new rules. Complete details can be found in the May 22, 2001 *Official Gazette* (1246 OG 106-107) or on the Internet at <http://www.uspto.gov>. See also MPEP 1606 more additional information concerning plant drawings.

### **Arrangement of the Specification**

1. With the passage of the American Inventors' Protection Act, Applicants' attention is drawn to 37 CFR 1.163(c)-(d) which is reproduced below:

37 CFR 1.163. Specification and arrangement of application elements in a plant application.

(c) The specification should include the following sections in order:

(1) Title of the invention, which may include an introductory portion stating the name, citizenship, and residence of the applicant.

- (2) Cross-reference to related applications (unless included in the application data sheet).
- (3) Statement regarding federally sponsored research or development.
- (4) Latin name of the genus and species of the plant claimed.
- (5) Variety denomination.
- (6) Background of the invention.
- (7) Brief summary of the invention.
- (8) Brief description of the drawing.
- (9) Detailed botanical description.
- (10) A single claim.
- (11) Abstract of the disclosure.

(d) The text of the specification or sections defined in paragraph (c) of this section, if applicable, should be preceded by a section heading in upper case, without underlining or bold type.

For Applicant's convenience, a black and white copy of a recent patent ( PP 13,049) has been enclosed. The format may have been changed somewhat by the printer. As a result, if there is any contradiction, Applicant should follow the format detailed in 37 CFR 1.163 as described above.

### **Objection to the Disclosure**

#### **37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

### 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. The specification must contain as full and complete a disclosure as possible of the plant. There are too many omissions in the description to name them all. The Examiner has enclosed the booklet "General Information about Traditional Plant Patents" to serve as a general tool for Applicant's convenience.

B. The specification must distinguish the instant plant over other similar varieties as well as its parents.

C. The specification must point out where and in what manner the plant was asexually propagated with an indication as to its genetic stability.

D. Where color is a distinctive feature of the plant, the color should be positively identified in the specification by reference to a designated color as given by a recognized color dictionary or color chart. The title of the color chart employed should be set forth in the specification. An example of such a color chart is The Royal Horticultural Society Colour Chart. The adaxial and abaxial leaf colors for mature and immature leaves, trunk, branch, flower bud, flower color, color of each of the sex organs such as anthers, stamen, stigma, style, and pollen, fruit color, seed color, peduncle color, and petiole color, for example, are each distinctive features of the plant.

E. The title of the invention must relate to the entire plant (MPEP 1610). As a result, the title of the invention must be changed to insert --plant-- after "hybrid".

F. The disclosure is objected to under 37 CFR 1.121(e) because the Latin name of the genus and species of the instant plant has not been set forth in the disclosure. 37 CFR 1.163(c)(4). Applicant needs to clarify the genus and species of the instant plant using the appropriate Latin binomial. The Latin binomial should be set in italics wherever it occurs in the specification, including in the title, disclosure, claim, and abstract.

G. In the interest of providing a description that is as complete as is reasonably possible, Applicant should set forth in the specification a quantification of the vigor, the leaf and leaf margin shape, leaf length and width, a description of the bud, flowers and flower organs including shape and number of various organs and flower scent. Additionally, the pedicel length, petiole length, description of the fruit and seed, flower and petal dimensions, and time of flowering should be set forth. Any other information included on the sample patent but not specified here should also be included in the description.



H. The claim shall be in formal terms to the new and distinct variety of the specified plant. It is improper to have the claim drawn to a "magnolia". Rather it must be such that it is directed to the new and distinct variety of magnolia **plant** (MPEP 1610, 37 CFR 1.164).

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

#### **Claim Rejections**

##### **35 U.S.C. 112, 1st & 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

#### **Future Correspondence**

Any inquiry concerning this communication from the Examiner should be directed to Anne Marie Grünberg whose telephone number is (703) 305-0805. The

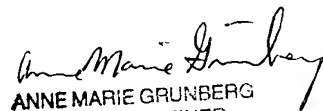
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Examiner can normally be reached Monday through Thursday from 6:00 am to 3:30 pm and alternate Fridays from 7:00 am to 3:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205. The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
ANNE MARIE GRUNBERG  
PATENT EXAMINER